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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,935

09/25/2006

Milisav Lazarevic

OSG-100

5442

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05/18/2009

EXAMINER

ALIE, GHASSEM

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

05/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/593,935

**Applicant(s)**

LAZAREVIC, MILISAV

**Examiner**

GHASSEM ALIE

**Art Unit**

3724

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 6-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 09/25/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

***Election/Restrictions***

1. Applicant's election with traverse of Group I (claims 1-17), Subgroup Ia (claims 3-5) and Species Ia (Fig. 1) in a reply filed on 03/03/09 is acknowledged. The traversal is on the ground(s) the two groups of claims differ by the power-take-off drive in claim 18. That is not correct. As stated in previous Office action, invention I (claims 1-17) relates to spur gears having different gear tooth pitch diameters. However, invention II (claims 18-20) relates to a shaft rotated by a gear for power-take-off drives of a cone and a bush for treating a tube cutter. As it is clear in claims 17 and 18 the common technical feature is well known in the art since the claims are an improvement to the existing art. The difference between the two groups are the improvements which are related to two different and distinct inventions. Applicant's argument that there is no showing of different art classification for these two groups or inventions is not persuasive. It should be noted that classification is not the only way to proof search burden. The search for each individual invention may overlap but they do not coincide identically throughout. Therefore, the search for the elected invention may not be sufficient for the other non-elected inventions. Therefore, each individual invention includes a different field of search. In addition, the text and subclass search that might be needed to look for the technical features of one of the inventions is not sufficient for finding the technical features of the other invention. In other words, each individual invention with at least a distinct feature has a separate status in the art and naturally requires a different field of search. Therefore, there is a serious burden on the Examiner to examine all the distinct individual inventions together in a single application and may degrade the quality of the examination since Examiner has a limited time to examine a single application. Applicant's

argument that claim 1 at least has a common special technical feature that is the common feature in dependent claims or Groups (IA-IJ) is not persuasive. However, there is no special technical feature in claim 1 that make a contribution over the prior art. It should be noted that “[w]hether or not any particular technical feature makes a “contribution” over the prior art, and therefore constitutes a ‘special technical feature,’ should be considered with respect to novelty and inventive step.” See MPEP 1850 Unity of Invention Before the International Searching Authority [R-6]; II. Determination of ‘Unity of Invention.” In this case, as the rejection of the claims over prior art indicates that is not the case. Therefore, claim 1 does not have a “special technical feature.” Therefore, the restriction requirement is proper. In addition, the search for each individual invention in Groups IA-IJ may overlap but they do not coincide identically throughout. Therefore, the search for the elected Group Ia may not be sufficient for all the other non-elected Groups.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2 and 6-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: “14” in page 4, line 24; “75” in page 7, line 24.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement

drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

4. The claims are objected to because they include reference characters which are not enclosed within parentheses. Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 and 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1 and 3-5, different parts are only distinguished by reference numbers. Therefore, it is confusing and it is not clear what are

specific parts without looking at the reference numbers. For example, claim 1, recites “shaft 56”, “shaft 66”, “gear 16” and “gear 17” are only identified by reference numbers instead of adjectives such as “a first shaft (56)”, “a second shaft (66)”, “a first gear (16)” and “a second gear (17).” In claim 3, “said gears 44, 77” is confusing, since it is not clear whether “gears” is a reference to the spur gears or “two other gears 44, 77.” The spur gears 16, 17 and two other gears should be clearly distinguished by adjectives or names instead of reference numbers. In claim 4, “said gears” is confusing. It is not clear which gears are being claimed. In claim 5, “gears 44 and 77” and “gears 16 and 17” should be distinguished by adjectives or names instead of reference numbers.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazarevic (6,065,212) in view of Nanzai (5,881,616). Regarding claim 1, as best understood, Lazarevic teaches substantially the claimed invention except that the gears 16, 17 have spur gear tooth pitch diameters D-I and D-2 in respective lengths extending through the axis and diametrically across the gears and with the length of the pitch diameter D-I of said gear 17 being different from the length of the pitch diameter D-2 of the gear 16 for the rotation of the gear 17 at a rotation speed different from the rotation speed of the gear 16. However, Nanzai teaches a powered pip cutter including a main gear 7 and a cam mounting gear 8 stacked in

parallel relationship similar to gears 16, 17 in Lazarevic. Nanzai also teaches that the gears 7, 8 have spur gear tooth pitch diameters in respective lengths extending through the axis and diametrically across the gears and with the length of the pitch diameter of said gear 7 being different from the length of the pitch diameter of the gear 8 for the rotation of the different from the rotation speed of the gear 7. It should be noted that gears 7 and 8 have different gear pitch diameters. See col. 3, lines 1-67 and col. 4, lines 1-32 in Nanzai. It would have been obvious to a person of ordinary skill in the art to provide Lazarevic's powered cutter with the different spur gear tooth pitch diameters for the spur gears, as taught by Nanzai, in order to prevent production of burrs on an inner side wall of a cut portion or on a cut face of the pipe.

***Allowable Subject Matter***

9. Claims 3-5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawashima (2005/0247171), Santana (3,848,489) and Kloster (4,422,238) teach a powered pipe cutter having spur gears with different numbers of teeth.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ghassem Alie/

Primary Examiner, Art Unit 3724

May 14, 2009